

REMARKS

Claims 1-38 are pending. By this Amendment, claims 1, 16, 19, 22 and 25 have been amended. No new matter is involved. Support for the amendments is found throughout Applicants' originally filed disclosure.

Applicants continue to traverse the holding of lack of unity/restriction requirement.

The Office Actions in this Application simply do not make out a prima facie case of lack of unity of the claimed invention. The assertion that the claimed inventions have no special technical features overlooks the current amendment to the claims. As a result of the claim amendments, the claims of the allegedly different groups of inventions clearly do have commonly recited special technical features. Under the circumstances, to accord Applicants' fundamental procedural and substantive due process, all claims should be examined on their merits.

One such commonly recited feature is "wherein the sound and/or image data includes delimiters spaced at regular intervals." Another commonly recited special technical feature is "including switching a displayed image when synchronization data indicates that a sound delimiter is read and/or for switching a sound when synchronization data indicates that a video delimiter is read, to avoid slippage between sound and image data."

Lastly, the assertion that there would be an undue burden to search the inventions recited in the Groups corresponding to withdrawn claims 13-24 is completely at odds with the fact that what is recited in the body of those claims is also recited in the body of the elected claims.

Accordingly, the holding of lack of unity should be withdrawn and all pending claims examined on their merits.

The Office Action rejects claims 1-4, 11, 12, 25-28, 35 and 36 under 35 USC 102(b) as anticipated by U.S. Patent 5, 668,601 to Okada et al. (hereinafter, "Okada"). This rejection is respectfully traversed.

In order to anticipate a claim, all features or limitations of a claim must be disclosed in a single reference either explicitly or inherently. See, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

All positively recited features of a claim must be addressed in an Office Action, In re Angstadt et al., 190 USPQ 214 (CCPA 1976); In re Alul et al., 175 USPQ 700 (CCPA 1972); and General Electric Company v. U.S., 198 USPQ 65 (US CIOt 1978).

The first feature addressed in the rejection is the preamble, which recites "a game machine." Okada does not disclose a game machine, per se. All that Okada discloses is that "[W]ide spread use of multimedia recording formats in personal computer, business and home entertainment systems has highlighted the need to process digitally recorded video and audio information at increasingly faster rates."

Just mentioning "personal computer, business and home entertainment systems" falls far short of disclosing a game machine. Okada simply does not disclose a game machine.

Accordingly, Okada does not anticipate claims 1-4, 11, 12, 25-28, 35 and 36.

Moreover, claims 1-4, 11, 12, 25-28, 35 and 36 recite "wherein the sound and/or image data includes delimiters spaced at regular intervals" and "switching a displayed image when synchronization data indicates that a sound delimiter is read and/or for switching a sound when synchronization data indicates that a video delimiter is read, including when

slippage has occurred between sound and image data.." Okada fails to disclose either of these features.

Accordingly, Okada does not anticipate claims 1-4, 11, 12, 25-28, 35 and 36.

The Office Action rejects claims 7-10 and 29-34 under 35 USC §103(a) as unpatentable over Okada. This rejection is respectfully traversed.

The rejection fails to make out a prima facie case of obviousness of the claimed invention for a number of reasons.

In the first place, claims 7-10 depend from claim 1 and claims 29-34 depend from claim 25 and contain all the features of claims 1 and 25. For the reasons stated above, Okada does not disclose those features.

In the second place, this rejection fails to address all of the features recited in claims 7-10 and 29-34 other than to state that "the limitations recited in the claims are well-known items in [a] game machine." Because Okada discloses that his invention is allegedly part of a home entertainment system, the Office Action concludes that it would be obvious to one of ordinary skill in the art to "incorporate the decoding system disclosed in Okada."

Applicants respectfully disagree.

Home entertainment systems are not taught by Okada to include "game machines" and the Office cannot, in a rejection, assume that it does without providing objective evidence thereof. As pointed out in the Amendment filed September 23, 2003, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Because the rejection fails to provide objective evidence that Okada's "home entertainment" systems denote game systems, this rejection is fatally defective.

Lastly, the Office Action does not establish proper motivation to operate the Okada system in a game in general, or in a game with the features recited in a number of the dependent claims.

Thus, the rejection of claims 1-10 and 29-34 is improper and should be withdrawn.

The Office Action rejects claims 37 and 38 under 35 USC §103(a) as unpatentable over Okada. This rejection is respectfully traversed.

Additionally, the assertions about what is known, found on pages 5 and 6 of the Office Action, are not based on objective evidence of record, but merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Accordingly, this rejection is fatally defective. Thus, the rejection is improper and should be withdrawn.

Furthermore, with respect to claim 37, that depends from claim 1, home entertainment systems are not taught by Okada to include "game machines" and the Office cannot, in a rejection, assume that it does without providing evidence thereof.

Moreover, claims 37 and 38 recite "wherein the sound and/or image data includes delimiters spaced at regular intervals" and "switching a displayed image when synchronization data indicates that a sound delimiter is read and/or for switching a sound when synchronization data indicates that a video delimiter is read, to avoid slippage between sound and image data." Okada fails to disclose either of these features.

Accordingly, even if Okada were modified as suggested, Okada would still not render the claimed invention obvious.

Also, a fundamental requirement of a prima facie case of obviousness includes an explanation of why one of ordinary skill in the art would have been motivated to make the proposed modification - a factor not mentioned or addressed in any manner in the rejection.

Regarding making a prima facie showing of obviousness of the claimed invention, the first requirement is that a showing of a suggestion, teaching, or motivation to modify the prior art reference is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This evidence may flow from the prior art reference itself, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489(Fed. Cir. 1997).

This rejection addresses the issue of motivation only in terms of what is known to one of ordinary skill in the art but fails to relate what is allegedly known, without presenting any evidentiary basis therefor, to why it would be obvious to modify Okada, which does not disclose a game machine, to include those features. Accordingly, the rejection does not make out a prima facie case of obviousness of the claimed invention.

Moreover, the rejection does not explain the desirability of the proposed modification of Okada. This must be done as part of making out a prima facie case of obviousness. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-4 (Fed. Cir, 1992). Additionally, a factual inquiry whether to modify a reference must be based on objective evidence of record,


not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Accordingly, claims 37 and 38 are patentable over Okada.

For at least the aforementioned reasons, Applicants respectfully submit that the restriction requirement should be withdrawn, claims 13-24 should be examined on their merits, and claims 1-38 should be allowed.

Should the examiner believe that anything further is needed to place the application in even better condition for allowance, the examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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